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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/659,241    09/11/00    KOPACIEWICZ    W    MCA-463

IM22/0705

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EXAMINER

LUDLOW, J

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 07/05/01

*6*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/659,241

Applicant(s)

KOPACIEWICZ ET AL.

Examiner

Jan M. Ludlow

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 25-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 of 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-24, 31-32, drawn to an apparatus, classified in class 422, subclass 101.
  - II. Claims 25-27, drawn to a method of use, classified in class 436, subclass 173.
  - III. Claims 28-30, drawn to a method of making, classified in class 436, subclass 174.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the apparatus could be made by another method, e.g., stacking the parts on top of one another and assembling the housing around the stack.
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the apparatus can be used for filtration without analysis.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Kevin Lemack on June 28, 2001 a provisional election was made with traverse to prosecute the invention of group I, claims 1-24, 31-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
8. Claims 1-8, 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "limited to said thickness" is unclear—equal to? Less than equal to? How is it limited? See also claim 17.

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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13. Claims 1-20, 22-24, 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fernwood et al.

Fernwood teaches a device having sample reservoirs 12, collection reservoirs 20, filtration substrate 13, and spouts 41 all fixed together by screws 26 and latches 30. The substrate 13 can be the same size as shown, but be a non-porous sheet with porous circular regions corresponding to reservoirs 12 (col. 3, lines 25-30). If the substrate is the same size as shown, then the filter portions are of the same thickness as the rest of the sheet. The filter regions can be adsorbents (col. 1, line 26) and exemplary filters are Teflon or Teflon with diatomaceous earth bound thereto (col. 5, line 66, col. 6, line 54). It is the examiner's position that adsorbent filters are inherently "functionalized" to be adsorbent. It is the examiner's position that the diatomaceous earth particles are entrapped in the porous matrix because they are bound.

14. Alternatively, claims 1-20, 22-24, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernwood et al.

15. The teachings of Fernwood are given above.

16. Fernwood fails to explicitly teach that the porous regions are limited by the thickness of the substrate (housing).

17. It would have been obvious to make the filter regions the same thickness as the non-porous sheet in order to make the alternative embodiment sheet 13 the same size as the sheet shown as taught by Fernwood. To the extent that the membranes taught by Fernwood are not inherently functionalized to be adsorbent, it would have been

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obvious to use functionalized adsorbent membranes in order to use known adsorbent membranes as taught.

18. Alternatively, claims 2, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernwood as applied to claims 1, 9 above, and further in view of Foltz.

19. Fernwood fails to explicitly teach that the diatomaceous earth particles are "entrapped" in the filter matrix.

20. Foltz teaches entrapment of adsorbent particles in filter matrixes to effect separation.

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use filters with entrapped adsorptive particles in order to provide a known type of adsorptive filter as taught by Foltz.

22. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernwood as applied to claims 17-19 above, and further in view of Bowers et al.

23. Fernwood fails to teach the sample reservoir and spout plate bonded to the filter substrate.

24. Bowers teaches a filtration system with sample reservoirs and an underdrain tray having spouts. The sample reservoirs are bonded to the underdrain tray with the filter 70 therebetween (col. 6, lines 1-11, Figure 10).

25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the drain, filter and sample reservoirs of Fernwood together

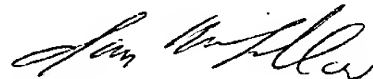
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in order to provide hermetic sealing as taught by Bowers, if one were willing to forego the advantages of reusing the reservoir and drain plate with a new filter medium.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (703) 308-4039. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jan M. Ludlow  
Primary Examiner  
Art Unit 1743

jml  
June 28, 2001